

REMARKS

STATUS OF THE CLAIMS

Claims 1-46 are pending. This Amendment corrects a typographical error in the specification, and amends claims 1, 2, 4, 11, 12, 18, 25, 26, 28, 35, 36, and 38. No new matter has been added.

INTERVIEW

Applicant thanks Examiner McAvoy for the courtesies extended to Applicant's representative, Carol L. Cole, during the personal interview of October 25, 2005. Applicant's record of the substance of the interview is incorporated into the remarks below.

REJECTIONS UNDER 35 U.S.C. § 103

A. The Examiner has rejected claims 1-46 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,942,470 to Norman et al. ("Norman"). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143 (8th ed. 2001). Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness because the Examiner has failed to point to the teaching or suggestion of all of the claim elements in the cited reference.

The Examiner has stated that "component (ii) of Norman meets the limitation in the claims of the alkylamine salt of a dialkylmonothiophosphate component." See Office

Action dated July 27, 2005, at 2. Moreover, the Examiner referred to columns 19-20 of Norman wherein "Norman allows for the addition of other conventional additives." *Id.* at 3. Norman also discusses gear oil base stocks at cols. 18-19. One of ordinary skill in the art would appreciate that these oils generally possess high levels of sulfur. As discussed at the interview, Norman does not teach or suggest an oil soluble lubricant additive package that yields a lubricating oil having a sulfur content of less than about 0.3 wt.%, as recited in the independent claims.

For at least the foregoing reasons, the Examiner has failed to establish that Norman teaches or suggests all of the claimed elements. Reconsideration and withdrawal of the rejection are respectfully requested.

B. The Examiner has rejected claims 25-46 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,342,531 to Walters et al. ("Walters"). Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness because the Examiner has failed to point to the teaching or suggestion of all of the claim elements in the cited reference.

The Examiner has stated that "component (b) meets the limitation of the at least one alkylamine salt of a dialkylmonothiophosphate component of the claims." See Office Action, at 3 (citations to Walters omitted). Moreover, the Examiner referred to columns 6-7 of Walters for teaching sterically hindered phenolic and amine antioxidants. *Id.* However, the Examiner failed to point to the teaching or suggestion in Walters of an additive package wherein the weight ratio of the alkylamine salt of a dialkylmonothiophosphate to the antioxidant is from about 10:1 to about 1:5, as presently recited in independent claim 25.

Walters teaches a lubricant composition comprising (a) at least one sulfur-containing antiwear or extreme pressure agent. See col. 1, lines 45-50, and line 60 to col. 2, line 19, and the Abstract. In particular, Walters teaches an additive concentrate comprising "a) 5 to 70% of at least one sulphur-containing antiwear or extreme pressure agent." *Id.* at col. 8, line 62 to col. 9. Walters does not teach or suggest an oil soluble lubricant additive package that yields a lubricating oil having a sulfur content of less than about 0.3 wt.%, as recited in the independent claims.

For at least the foregoing reasons, the Examiner has failed to establish that Walters teaches or suggests all of the claimed elements. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

FEES

It is believed that there are no fees associated with this filing. However, in the event the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 05-1372. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 05-1372.

Respectfully submitted,

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